

Appln No. 10/650,348  
Reply to Office Action of March 23, 2006

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REMARKS

35 U.S.C. § 103

Claims 23, 26, 27, 29 and 33-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Benzing (WO 00/51810) in view of Oldeman (U.S. 4,922,774). This rejection is respectfully traversed for the following reasons. First, neither Benzing nor Oldeman teach or suggest that the cutting edge of the cutting device is positioned above the anvil at the transition point a gap distance  $d$ ,  $d$  being slightly less than the thickness of the cord reinforced component.

Further, to properly establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). [Emphasis added.]

The examiner has not explained why the artisan would have been motivated to replace Benzing's support surface with Oldeman's anvil. Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Further, the teachings in Benzing and Applicant's invention are concerned with cutting reinforced rubber, while the Oldeman reference is concerned with cutting through non-reinforced rubber. Thus one skilled in the art would not be motivated to consider the teachings in Oldeman.

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In light of this amendment, all of the claims now pending in the subject patent application are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,

  
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